

### **REMARKS**

These Remarks are submitted under 35 U.S.C. § 132 and 37 C.F.R. § 1.111 in response to the Office Action mailed June 13, 2008.

#### **Summary of the Examiner's Action and Applicants' Response**

The Examiner rejected Claims 1-2, 4-7, and 9-17 under 35 U.S.C. § 101. The Examiner stated that Claims 18-21 and 23-34 are allowed. Claims 1, 18, 23, 27, 32, and 33 have been amended. Claims 35-38 have been added. Applicants respectfully traverse the rejection. Claims 1, 2, 4-7, 9-21, and 23-38 are pending.

#### **Response to Rejection of Claims 1-2, 4-7, and 9-17, under 35 U.S.C. § 101**

The Examiner has rejected Claims 1, 2, 4-7, and 9-17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner stated that the basis of this rejection is “whether the invention produces a useful, concrete, or tangible result”. The Examiner stated that the preamble of Claim 1 recites “A system”. (Applicants respectfully note parenthetically that the preamble of Claim 1 recites a method, not a system.) The Examiner stated that the steps in Claim 1 of “creating...”; “developing...”; “associating...”; “receiving...”; and “obtaining...”, “which comprise the claim as a whole are mere steps in the abstract without setting forth a practical application for producing any useful, concrete, and tangible result. (See Interim Guidelines, IV (C)(1, 2))”. The Examiner stated that Claims 2, 4-7, and 9-17, which depend on Claim 1, also fail the test above because they fail to limit to a particular structure.”

The Examiner's sole basis for the rejection was that the invention did not produce a useful, concrete, and tangible results. Applicants respectfully submit that this test applied by the Examiner is no longer the proper test to apply in determining whether a claim is statutory under 35 U.S.C. § 101. (See *In re Bilski*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2008) (*en banc*) (docket no. 2007-1130, decided October 30, 2008). The Federal Circuit held in *In re Bilski* that instead, the sole proper test to determine whether a claim is patent-eligible under 35 U.S.C. § 101 is the “machine-or-transformation test.” According to the machine-or-transformation, “a claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms

a particular article into a different state or thing”. (*In re Bilski*, page 10, citing *Gottschalk v. Benson*, 409 U.S. 63, 70). It is respectfully submitted that the claim is not required to involve any transformation of the underlying physical object that the data represents, but it is sufficient if the data represents a physical object. (See *In re Bilski* on page 26).

Applicants have amended Claim 1 such that Claim 1 begins “[a] method of extracting data of interest from at least one web site in a plurality of web sites, wherein the data of interest is information associated with a product, ...”. Applicants respectfully submit that the extracted data of interest represents a physical object, i.e., a **product**, and therefore, Claim 1 is statutory process under 35 U.S.C. § 101.

For the above reasons, Applicants respectfully submit that Claim 1 is a statutory process under 35 U.S.C. § 101.

Claim 23 is a method claim and has also been amended to add “wherein the data of interest is information associated with a product” in the preamble. Thus, Applicants respectfully submit that Claim 23 is a statutory process under 35 U.S.C. § 101 for the same reasons given above for Claim 1.

Claim 1 has also been amended to replace “querying web sites” with “querying the at least one website” and to replace “wherein when the data of interest includes data of interest from at least two web sites of the plurality of web sites, the data of interest from the at least two web sites is extracted” with “(D) extracting said data of interest from the at least one web site of the plurality of web sites and storing said extracted data of interest”. Generally similar amendments have been made to Claims 18, 23, and 27. Claims 32 and 33 have been amended to replace “[a] computer implemented method of obtaining data of interest from a plurality of web sites comprising:...” with “[a] computer implemented method of obtaining data of interest from at least one web site of a plurality of web sites comprising:...” and to replace “(C) obtaining said data of interest by querying web sites in the plurality of web sites using the value and the extraction patterns in the respective descriptions of data of interest” with “(C) obtaining said data of interest by querying the at least one web site of web sites in the plurality of web sites using the value and the extraction patterns in the respective descriptions of data of interest”. Support for the amendments is found throughout the specification.


Claim 35-38 have been added and include elements formerly in Claims 1, 18, 23, and 27 respectively, that specify at least two web sites. Support for the added claims is found throughout the specification.

**Conclusion**

For the above reasons, Applicant respectfully submits that all pending claims, Claims 1, 2, 4-7, 9-21, and 23-38, in the present application are allowable. Such allowance is respectfully solicited.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 984-8200.

Respectfully submitted,

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